



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

FISH & RICHARDSON PC  
PO BOX 1022  
MINNEAPOLIS MN 55440-1022

**COPY MAILED**

**DEC 20 2005**

**OFFICE OF PETITIONS**

In re Application :  
Joseph A. Zupanick :  
Application No. 10/004,316 :  
Filed: October 30, 2001 :  
Atty Docket No. 067803.0162 :  
: DECISION ON APPLICATION  
: FOR PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(B)", filed August 18, 2005. Applicant request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from eighty-four (84) days to two hundred thirteen (213) days.

The application for patent term adjustment is **DISMISSED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **zero (0) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 18, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is eighty-four (84) days. On August 18, 2005, Applicant timely<sup>1</sup> submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is two hundred thirteen (213) days.

---

<sup>1</sup> Applicants filed the instant application for patent term adjustment together with the payment of the issue fee.

Applicant fails to state whether the patent issuing from the application is subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of eighty-four (84) days based on an adjustment for PTO delay of eighty-four (84) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), reduced by zero (0) days of applicant delay.

Applicant argues that the PTO should have been assessed additional delay of one hundred twenty-nine (129) days pursuant to 37 C.F.R. § 1.703(a)(3). Applicant filed an RCE on September 9, 2004. However, the Office did not mail an action in response to the RCE until May 18, 2005. Accordingly, the Office should have been assessed PTO delay of one hundred twenty-nine (129) days.

However, a review of the application file reveals that applicant should have been assessed additional delay of one hundred ninety-six (196) days, pursuant to 37 C.F.R. § 1.704(c)(8), for the filing of an IDS on March 24, 2005. As stated above, applicant filed an RCE on September 9, 2004. On March 24, 2005, applicant filed an IDS. The IDS did not contain the statement required by 37 CFR 1.704(d). Accordingly, applicant should have been assessed delay of one hundred ninety-six (196) days.

Moreover, the applicant should have been assessed additional delay for filing a petition to withdraw from issue. The issue fee was originally paid on December 30, 2003. Applicant filed a petition to withdraw from issue on June 28, 2004. Accordingly, pursuant to 37 C.F.R. § 1.704(c), applicants should have been assessed delay of one hundred eighty-one (181) days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **zero (0) days** (213 (84+129) days of PTO delay, reduced by 377 (181+196) days of applicant delay).

Receipt of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged.

The application file is being forwarded to the Office of Patent Publication for processing into a patent. Any delays in not issuing the patent under 37 C.F.R. 1.704(a)(4) or 1.704(b) will be reflected in the issue notification letter that is mailed to applicant approximately three weeks prior to the issue date.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571) 272-3207.



Kery Fries  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy